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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/707,509
Filing Date: December 18, 2003
Appellant(s): RYAN ET AL.

George M. Macdonald
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 15, 2009 appealing from the Office action mailed January 12, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Related application 10/707,510 is on appeal to the Board and has a similar disclosure.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patents:

2003/0101148	Montgomery, et al.	5-2003
6,687,684	Whitehouse, et al.	2-2004
6,032,138	McFiggans, et al.	2-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-18, 21-25, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery, et al., U.S. Pat. Pub. No. 2003/0101148 (Reference A of the PTO-892 part of paper no. 20070502) in view of Whitehouse, et al., U.S. Pat. No. 6,687,684 (Reference A of the PTO-892 part of paper no. 20080611).

As per claims 14 and 21, Montgomery teaches a method for detecting fraud by a user of a shipping label [and transportation item] having an identifier using a server comprising: receiving a print success indicator at the server, wherein the print success indicator is associated with a print request for the shipping label having a first identifier [and of the identifier that is associated with the transportation item] (§ 0127), and wherein the print success indicator comprises a response or a default indication if no response is received within an allocated response time period (§ 0168); receiving a list of identifiers at the server representing items processed by [and used in] a shipping stream (§ 0083); if the print success indicator is negative, reporting a potential fraud using the server if the first identifier is present in the list of identifiers (§§ 0168, 0176);

Art Unit: 3628

and if the print success indicator is positive, reporting a potential fraud using the server if the first identifier is present at least twice in the list of identifiers (§ 0109).

Although Montgomery teaches that shipping labels are known to be reprinted in the event of a failure (§ 0020), it does not teach the particular request involved is a reprint request rather than a simple print request; which is taught by Whitehouse (Abstract). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to modify Montgomery to support the event that user needs to reprint the same unused postage after an error has occurred (as taught by Whitehouse, col. 1, lines 53-59, col. 2, lines 7-12). Moreover, since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of the reprint request in Whitehouse for the print request taught in Montgomery. The combination would have been prima facie obvious because it is merely the simple substitution of one known element for another that could be implemented through routine engineering to produce only predictable results.

As per claims 15 and 22, Montgomery in view of Whitehouse teaches the methods of claims 14 and 21 as described above. Montgomery further teaches the list of identifiers is received periodically (§ 0117).

As per claims 16 and 23, Montgomery in view of Whitehouse teaches the methods of claims 14 and 21 as described above. Montgomery further teaches the list of identifiers comprise identifiers recognized for a period of time (§ 0086).

As per claim 17, Montgomery in view of Whitehouse teaches the method of claim 15 as described above. Montgomery further teaches the list of identifiers is received daily (§ 0117).

As per claims 18 and 25, Montgomery in view of Whitehouse teaches the methods of claims 16 and 23 as described above. Montgomery further teaches the list of identifiers comprises identifiers recognized during the prior one year (§ 0086). Montgomery does not teach the time period is the prior six months. However, it would have been prima facie obvious to one having ordinary skill in the art at the time of

invention to incorporate the time period is the prior six months because this is merely an optimized range of time. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

As per claim 24, Montgomery in view of Whitehouse teaches the method of claim 22 as described above. Montgomery further teaches the identifiers comprise identifiers from a plurality of sets of identifiers (§ 0087).

As per claim 28, Montgomery in view of Whitehouse teaches the method of claim 21 as described above. Montgomery further teaches the transportation item is an item selected from the group: envelopes, post cards, postage labels, labels and packages (§ 0081).

As per claim 29, Montgomery in view of Whitehouse teaches the method of claim 21 as described above. Montgomery further teaches the identifiers are selected from at least one set of identifiers wherein the set of identifiers includes one or more from the group: planet codes, delivery confirmation numbers, IBI indicia, identifiers including the combination of a piece count and permit number, and identifiers including the combination of a meter number and ascending register (§ 0095).

As per claims 30-32, Montgomery in view of Whitehouse teaches the method of claim 14 as described above. Montgomery further teaches the identifiers are selected from at least one set of identifiers comprising planet codes (§ 0140); identifiers including the combination of a meter number and ascending register (§§ 0008, 0083); and identifiers including the combination of a piece count and permit number (§ 0083; examiner is interpreting a postage vendor ID and user account number as a permit number; see also § 0097 (account-specific piece count), § 0140 (meter or account ID) and Table 2).

Claims 19, 20, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery, et al. in view of Whitehouse, et al. as applied to claims 19 and 26 above, further in view of McFiggans, et al., U.S. Pat. No. 6,032,138 (Reference B of the PTO-892 part of paper no. 20070502).

As per claims 19 and 26, Montgomery in view of Whitehouse teaches the methods of claims 15 and 22 as described above. Montgomery does not teach reporting a potential fraud if an identifier having a successful print indicator is not recognized within an expected package period; which is taught by McFiggans (col. 2, lines 56-60). It would have been prima facie obvious to incorporate the above teachings of McFiggans in order to automatically feed back information on undelivered mail (as taught by McFiggans, col. 2, line 60).

As per claims 20 and 27, Montgomery in view of Whitehouse and McFiggans teaches the methods of claims 19 and 26 as described above. Montgomery further teaches the expected package period is one period selected from the group of one day, one week, one month and six months (¶ 0169).

(10) Response to Argument

A. Montgomery is sufficient to teach the claimed print success indicators.

Appellant argues that Montgomery is not sufficient to teach the claimed print success indicators. Examiner maintains that Montgomery is sufficient to teach the claimed print success indicators, although acknowledging that they are for a print request and not specifically a reprint request of the same label. Montgomery teaches that once the data is acquired, "the barcodes will be printed on the label 200 as a single step" (¶ 0127). Also, a second label is printed "if the printing process fails in some way" (¶ 0168). While it does not use the specific language "print success indicator" or "negative print success indicator," identity of terminology is not a requirement of a prior art reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). There is no claim language that specifies what form this "indicator" must take. By confirming that both the ID and indicium are returned and printed, the system receives a "print success indicator." Similarly, by noting that the printing process resulted in a failure rather than a success, the system is considered sufficient to disclose the claimed indicator of "negative print success."

Any differentiation between the indications in Montgomery and the claimed "indicators" would require importing limitations from the Specification as to what form

Art Unit: 3628

these indicators take. However, "a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant correctly notes that Montgomery does not teach a reprint of the same label. Brief, page 10. However this has been acknowledged in the previous rejections and again above. A printing that occurs after a failed printing can fairly be considered a "reprint" in such instances even though the tracking ID may be different. The printer is still taking a reprint action to account for the failure. Whitehouse is relied upon to show that reprinting the same label (rather than one with a new tracking ID) is old in well-known in the art of mail preparation. Printing and reprinting share many of the same characteristics and functions. Accordingly, it would have been obvious to use the fraud prevention techniques disclosed in Montgomery as applicable to original printing for the reprints discussed in Whitehouse.

B. Montgomery does not teach away from the claimed invention.

Appellant argues that Montgomery teaches away from the claimed invention because the reference discloses a second, different, label is printed rather than a reprint of the original label (as taught by Whitehouse, Abstract). Brief, pages 10-11. Examiner respectfully disagrees. Simply because more than one alternative embodiment exists in the prior art does not rise to a teaching away. "The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). In response to this line of reasoning presented in the Final Office Action, Appellant submits in the Brief that it is faulty because Montgomery individually describes only the one method of printing another label. Brief, page 11. However, this argument ignores the teachings of the secondary reference (which must be viewed along with

Art Unit: 3628

Montgomery in light of the rejections above), and that the cited passage of *Fulton* plainly notes the prior art's mere disclosure of multiple alternatives (not a single reference's disclosure) does not necessarily rise to a teaching away. Indeed, if the alternative solutions were present in the same reference Montgomery a rejection under § 103 rather than § 102 would likely not be necessary at all. When discussing a possible "teaching away" it is necessary to look at the disclosed solutions of both references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, the prior art discloses multiple solutions for reprinting labels in an effort to combat postage fraud, as shown in the cited references Montgomery and Whitehouse. Nothing in Montgomery's disclosure appears to present the reprinting the same label rather than printing a second label as an impracticable solution, just not the preferred option for that system. Moreover, if a reprint shipping label failed in the same way as an original printing, Montgomery's fraud prevention techniques would still discover it if it subsequently showed up in the mail stream and was flagged misprinted as potential fraud (see (¶¶ 0175-77)).

Appellant makes two citations to the record to support the assertion that Montgomery explicitly teaches away from the claimed invention. Brief, page 11 (citing ¶¶ 0168, 127). A review of these cited sections shows that a per-print tracking ID is certainly the preferred embodiment of Montgomery's system, but Examiner is unable to find any passages that present the reprinting in Whitehouse as criticized or discredited (as required by *Fulton*). The record does not indicate any evidence that one skilled in the art would conclude that Whitehouse's reprinting is an undesired possible solution after reading Montgomery. Appellant also presents the claimed invention's advantage of not charging for postage twice. However, this feature is not recited in the rejected claims (and accordingly the claim reads upon an embodiment wherein postage is in fact charged twice), and in any case is also taught by the secondary reference. In view of

Art Unit: 3628

the above, Examiner submits that Montgomery does not teach away from the claimed invention.

C. Montgomery discloses a "permit number" as broadly claimed.

Appellant argues that a postage vendor ID in Montgomery cannot fairly be considered a "permit number." Brief, 11-12. However, Appellant does not address Montgomery's additional disclosure of "a postage vendor ID and user account number" (§ 0083), an identifier as a "meter or account ID" (§ 0140) and that an indicia can include a "Certificate Serial Number" (Table 2). The only description of a "permit number" provided in the Specification (§ 0089 of the published application) is no greater detail than that of claim 32 itself. Appellant sets forth no preferred construction of the term in the Brief, only a conclusion that it is not taught by the cited art. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). Any distinction between the claim language and Montgomery's disclosure would violate this principle of claim construction, as it would require imputing requirements to the broadly disclosed "permit number" that can be found neither in the claim itself nor even in the Specification. As such, Examiner maintains that the rejection is proper.

D. Montgomery and Whitehouse are properly combined.

As set forth above in Section B., one of skill in the art would naturally look to both Montgomery and Whitehouse when approaching the problem of misprinted postage fraud because they are both concerned with that issue. Appellant argues that, nevertheless, the references are not properly combined because the resultant combination would render it "not suitable for the intended purpose of the initial reference." Brief, page 12. As a threshold matter, the "intended purpose" of both Whitehouse and Montgomery is the same: to detect fraud in a mail processing environment. Therefore, it is not completely clear as to how when combined they would not be suitable for this same purpose.

When a suggested combination would require a substantial reconstruction and redesign of elements and a change in the basic principles under which the reference was designed to operate, the combination may be improper. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). The combination of Montgomery and Whitehouse satisfies both parts of this inquiry, and is therefore a proper combination of prior art references. Substantial design and reconstruction is unnecessary, as both systems use similar hardware and software elements (as well as the same inventors). The only differences are the tracking ID's on the labels printed after a failure (whether it is new or the same), modifying Montgomery to use Whitehouse's reprinting technology would require minor engineering changes. Also here, in contrast to *Ratti*, the principles of operation remain the same. Montgomery's core principles of printing postage and tracking ID detection to discourage fraud all remain the same, only the specific ID's change.

The *Ratti* court reversed a rejection because it recognized a fundamental difference in operations that would result in an inoperative combination. *Id.* That is not the case here. The Examiner has consistently made findings that the level of skill displayed in the references evinces an ability to substitute Whitehouse's reprint of a shipping label into Montgomery; and then subsequently search the mailstream for fraud if the ID is present twice in a predictably similar and successful manner. Appellant has not carried the burden for disputing these findings by submitting adequate evidence to overcome them. "When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007) (citing *United States v. Adams*, 383 U.S. 39, 50-51 (1966)). This modified functionality would imbue Montgomery's system with new and useful features that relate to the same principles and method of operation (i.e., postage printing and fraud detection) that are the focus of the primary reference—they would not destroy its ability to function properly.

E. The rejections under § 103(a) are not the result of hindsight reconstruction.

Art Unit: 3628

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Brief, pages 12-13), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the time based detection of McFiggans was within the level of ordinary skill at the time the claimed invention was made, and is in the same field of invention (mail processing) as the other references and the claimed invention. Additionally, Appellant's assertion that Montgomery is not at all concerned with time-based fraud problems is not supported by any citations to the record. Montgomery takes some temporal considerations into account when attempting to detect fraud (see, e.g., ¶¶ 0169-73), and even if this was not the case the argument focuses on Montgomery only rather than the combined disclosures of Montgomery, Whitehouse, and McFiggans. When these disclosures of similar mail processing systems are properly viewed together as set forth in the rejections above they render the claimed invention unpatentable under § 103(a), and these rejections should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3628

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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